



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/717,571	11/21/2003	Koji Shigemura	1670.1020	9396
49455 7590 06/02/2008 STEIN, MCEWEN & BUI, LLP 1400 EYE STREET, NW SUITE 300 WASHINGTON, DC 20005			EXAMINER LIN, JAMES	
			ART UNIT 1792	PAPER NUMBER
			MAIL DATE 06/02/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

6-2-08

glm

In re application of	:	
Koji Shigemura	:	DECISION
Serial No. 10/717,571	:	ON
Filed: November 21, 2003	:	PETITION
For: DEPOSITION MASK FRAME ASSEMBLY,	:	
METHOD OF FABRICATING THE SAME, AND :	:	
METHOD OF FABRICATING ORGANIC	:	
ELECTROLUMINESCENT DEVICE USING THE	:	
DEPOSITION MASK FRAME ASSEMBLY	:	

This is a decision on the PETITION UNDER 37 CFR 1.181(a) FOR WITHDRAWAL OF FINALITY OF OFFICE ACTION AND RESTARTING OF PERIOD FOR RESPONSE filed May 12, 2008.

On August 27, 2007, an appeal brief was filed, and was eventually followed on December 19, 2007 by an examiner's answer, which included a new grounds of rejection. As required, a reply brief was filed February 14, 2008 responding to the new grounds of rejection. The examiner thereupon reopened prosecution and issued a final rejection on April 10, 2008.

On May 12, 2008, the instant petition was timely filed and is before the Director of Technology Center 1700 for consideration. The petition requests withdrawal of the finality of the April 10, 2008 action and restarting of the period for response thereto.

As explained below, the request to withdraw finality is **GRANTED**; the request to restart the period for response is **DENIED**.

DECISION

Applicant first asserts that the certified translation included with the reply brief is not 'new evidence' and thus the examiner's reopening of prosecution is improper. Treatment of a reply brief is explained in MPEP 1208 (II), reproduced in part below:

In addition, the examiner may:

- (A) Withdraw the final rejection and reopen prosecution to respond to the reply brief (see MPEP § 1207.04); or
- (B) Furnish a supplemental examiner's answer responding to any new issue raised in the reply brief (see MPEP § 1207.05).

Any supplemental examiner's answer responding to a new issue raised in a reply brief must be approved by the Technology Center (TC) Director or designee. 37 CFR 41.43(a)(2) prohibits a supplemental examiner's answer responding to a reply brief from including a new ground of rejection. After the filing of a reply brief, any new ground of rejection responding to a reply brief must be by way of reopening of prosecution. See MPEP § 1207.04. The examiner's decision to withdraw the final rejection and reopen prosecution to enter a new ground of rejection requires approval from the supervisory patent examiner, which approval must be indicated in the Office action setting forth the new ground of rejection. See MPEP § 1207.04.

Thus the examiner may, with appropriate supervisory approval, reopen prosecution whether the certified translation is considered 'new evidence' or not. Since the action reflects that supervisory approval to reopen was given, the examiner's reopening of prosecution was not, in and of itself, improper.

Reopening of prosecution after a brief or reply brief is filed is explained in MPEP 1207.04, reproduced in part below:

The examiner may, with approval from the supervisory patent examiner, reopen prosecution to enter a new ground of rejection after appellant's brief or reply brief has been filed. The Office action containing a new ground of rejection may be made final if the new ground of rejection was (A) necessitated by amendment, or (B) based on information presented in an information disclosure statement under 37 CFR 1.97(c) where no statement under 37 CFR 1.97(e) was filed. See MPEP § 706.07(a). Any after final amendment or affidavit or other evidence that was not entered before must be entered and considered on the merits.

Thus an Office action following a brief or reply brief may be made final only if the new grounds of rejection was necessitated by amendment or based on information presented in certain information disclosure statements. Neither of these conditions is met here, since the new grounds of rejection was in no way necessitated by amendment nor based on information presented in an IDS. Contrary to the examiner's action, the rejection does contain a 'new grounds of rejection' since the rejection based on Tsuchiya et al. was not previously contained in an action on the merits under 37 CFR 1.104. Consequently, while the examiner may reopen prosecution with a new action, such action must be non-final.

Since the new ground of rejection was not necessitated by applicant's amendment, applicant's request to withdraw the finality of the April 10, 2008 action is **GRANTED**.

Applicants also request that the period for responding to the outstanding office action be restarted. Section (f) of 37 CFR 1.181 states:

(f) The mere filing of a petition will not stay any period for reply that may be running against the application, nor act as a stay of other proceedings. Any petition under this part not filed within two months of the mailing date of the action or notice from which relief is requested may be dismissed as untimely, except as otherwise provided. This two-month period is not extendable.

Even upon withdrawal of the finality of the April 10, 2008 office action, the grounds of rejection set forth in the office action would still apply and applicants would still have an obligation to respond in a timely manner. Because the rule clearly states that the filing of a petition will not stay any period for reply that may be running against the application, the request for restarting the period for response is **DENIED**. The period for response set forth in the April 10, 2008 office action still applies.



Jacqueline M. Stone, Director
Technology Center 1700
Chemical and Materials Engineering

STEIN, MCEWEN & BUI, LLP
1400 EYE STREET, NW
SUITE 300
WASHINGTON DC 20005.